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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,407	11/16/2001	Anthony DiSalvo	PPC-812	3311

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PHILIP S. JOHNSON  
JOHNSON & JOHNSON  
ONE JOHNSON & JOHNSON PLAZA  
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

KIDWELL, MICHELE M

ART UNIT PAPER NUMBER

3761

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/991,407

Applicant(s)

DISALVO ET AL.

Examiner

Michele Kidwell

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-16 is/are allowed.
- 6) ☒ Claim(s) 1-14 and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08/11/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 2, 6 – 14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Bucalo (US 4,232,673).

With respect to claim 1, Bucalo discloses an absorbent device for insertion into a vaginal cavity (col. 8, lines 36 – 40), the absorbent device comprising an absorbent body (136) having a shape and an indicator structure arranged and configured within the absorbent body (figure 12), the indicator structure comprising a resilient member (138) maintained in a strained configuration by a restraint (140); wherein the resilient member is capable of reverting to a relaxed configuration to distort the shape of the absorbent body in a manner discernable to a user upon the weakening of the restraint and the restraint weakens upon exposure to moisture as set forth in col. 8, lines 40 – 44 and 51 – 59.

The examiner contends that the shape distortion of the absorbent device can at least be discerned by the user observing the absorbent device prior to insertion and upon removal to visibly detect the change in shape caused by the expansion of the container.

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With reference to claim 2, Bucalo discloses an absorbent device wherein the absorbent body comprises absorbent material as set forth in col. 8, lines 36 – 38.

Regarding claim 6, Bucalo discloses an absorbent device wherein the restraint maintains the resilient member in a compressed configuration as set forth in col. 8, lines 45 – 48 and in figure 12.

With reference claim 7, Bucalo discloses an absorbent device wherein the restraint maintains the resilient member in a stretched configuration as set forth in col. 4, lines 28 – 33.

As to claim 8, Bucalo discloses an absorbent device wherein the restraint maintains the resilient member in a bent configuration as set forth in col. 8, lines 45 – 48 and in figure 12.

With respect to claim 9, Bucalo discloses an absorbent device wherein the resilient member is in the shape of a ring as set forth in figure 12.

With reference to claim 10, Bucalo discloses an absorbent device wherein the resilient member is a spring as set forth in col. 8, lines 42 – 44.

Regarding claim 11, Bucalo discloses an absorbent device wherein the resilient member is formed of plastics, metals and combinations thereof as set forth in col. 8, lines 40 – 42.

With respect to claim 12, Bucalo discloses an absorbent device wherein the restraint comprises a water soluble material as set forth in col. 8, lines 19 – 22.

As to claim 13, Bucalo discloses an absorbent device wherein the restraint comprises gelatin as set forth in col. 8, lines 19 – 22.

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With respect to claim 14, Bucalo discloses an indicator device comprising a resilient member (138) maintained in a strained configuration by a restraint (140) wherein the resilient member is capable of reverting to a relaxed configuration upon weakening of the restraint and the restraint weakens upon exposure to moisture as set forth in col. 8, lines 42 – 50.

Regarding claim 17, Bucalo discloses method for making an absorbent device comprising the steps of a) manipulating a resilient member into a deformed condition; b) applying a restraint to maintain the resilient member in the deformed condition and to form an indicator structure and forming an absorbent body having a shape and containing the indicator structure (col. 8, lines 36 – 48) wherein the resilient member is capable of reverting to a relaxed configuration to distort the shape of the absorbent body in a manner discernable to a user upon the weakening of the restraint and the restraint weakens upon exposure to moisture as set forth in col. 8, lines 40 – 44 and 51 – 59.

The examiner contends that the shape distortion of the absorbent device can at least be discerned by the user observing the absorbent device prior to insertion and upon removal to visibly detect the change in shape caused by the expansion of the container.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 – 5 and 18 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bucalo (US 4,232,673).

The difference between Bucalo and claim 3 is the provision that the absorbent material is formed of fibers, foams or combinations thereof.

It would have been obvious to one of ordinary skill in the art to form the absorbent material of Bucalo from fibers, foams or combinations thereof because Bucalo states that the tampon may be made of any suitable absorbent material (col. 8, lines 35 – 37) and the use of fibers, foams or combinations thereof for the formation of absorbent material is extremely well known in the art.

As to claim 4, Bucalo teaches an absorbent device wherein the fibers are hydrophilic as set forth in col. 8, lines 36 – 38.

Regarding claim 5, Bucalo teaches an absorbent material wherein the fibers are absorbent as set forth in col. 8, lines 36 – 38.

The difference between Bucalo and claim 18 is the provision that the absorbent body is formed around the indicator structure.

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The difference between Bucalo and claim 19 is the provision that the absorbent body is formed and the indicator structure is inserted therein.

The examiner has consulted the instant specification and concludes that forming the absorbent body around the indicator structure or forming the absorbent body and then inserting the indicator structure does not solve any stated problem or produce any unexpected result and it appears that the absorbent device will perform equally well in either instance.

It would be obvious to one of ordinary skill in the art to either form the absorbent body around the indicator structure or form the absorbent body and insert the indicator structure therein since it has been held that rearranging parts of an invention involves only routine skill in the art.

***Allowable Subject Matter***

Claims 15 – 16 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: the overall claimed method of absorbing aqueous vaginal fluids comprising the steps of inserting a first absorbent device into a vaginal cavity wherein the absorbent device comprises an absorbent body and an indicator structure maintained in a strained configuration by a restraint and allowing the absorbent device to absorb sufficient aqueous vaginal fluids to weaken the restraint and detect changed dimensions of the absorbent device caused by the reversion of the resilient member to a relaxed configuration while inserted has neither been anticipated nor rendered obvious by the prior art of record.

### ***Response to Arguments***

Applicant's arguments filed August 11, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that Bucalo fails to direct the person of ordinary skill in the art to the present invention which is directed to a significantly different purpose, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Further, the examiner reminds the applicant that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**



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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 571-272-4935. The examiner can normally be reached on Monday - Friday, 5:30am - 2:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on 571-272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michele Kidwell  
Examiner  
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